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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,386	11/23/2001	Raymond John Herbert	5081	4332
26936	7590	10/19/2006	EXAMINER	
SHOEMAKER AND MATTARE, LTD 10 POST OFFICE ROAD - SUITE 110 SILVER SPRING, MD 20910			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/990,386	<b>Applicant(s)</b> HERBERT, RAYMOND JOHN	
	<b>Examiner</b> Calvin L. Hewitt II	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Status of Claims***

1. Claims 1-4 have been examined.

***Response to Arguments/Amendments***

2. Applicant is of the opinion that the prior art of Sievel et al. does not read on Applicant's claims. Specifically, Applicant asserts that the prior art does not teach print data signals that include "first print data signals defining a valid postage indicium and second print data signals defining a void marking", because Sievel et al. only teaches data signals comprising "valid indicium" and "void" in the alternative and not simultaneously (Remarks, 8-1-06, page 6, second full paragraph). Such an interpretation, however, is not supported by the Specification. On page 7, lines 15-31, Applicant recites at least two print data signals, one for a valid indicium and "additional print data signals which would cause print of data or a pattern" such as "void" (Specification, page 7, lines 20-31). Therefore, as Sievel et al. disclose a print data signal for valid indicium and another print data signal defining a "void" marking, Sievel et al. continue to read on Applicant's claims.

The following assertions of fact have gone unchallenged and are now considered admitted prior art:

- disabling a postage meter if it is not operating correctly
- storing image and/or data to be printed on a mailpiece as a bitmap in memory

Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection (see 112 first paragraph below).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites preventing "operation of the authorized printing means by the second print data signal". In other words, claim 1 recites preventing the second print data signal from controlling the authorized printing means in other words. Therefore, claim 1 is not supported by Applicant's Specification as it discloses preventing the void marking from being printed and not the indicium from being printed as result of the void marking (Specification, figures 2 and 3; page/line 8/17-9/11; page 9, lines 16-28). Claim 1 is also rejected as the print data signal does not simultaneously include both a first and second print signal (Specification, page 7, lines 15-31).

Claims 2-4 are also rejected as they depend from claim 1.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sievel et al., U.S. Patent No. 4,780,835.

As per claim 1, Sievel et al. teach a postage meter (column 4, lines 11-19) that includes a first control means for generating print signals defining an invalid postage indicium where the print signals comprise a void marking and a valid postage indicium (figure 5B). Sievel et al. also teach authorized means for printing an indicia (figure 1) and means for preventing the void marking from being printed (figure 5B).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sievel et al., U.S. Patent No. 4,780,835.

As per claim 2, Sievel et al. teach a printer printing an indicia (figure 1) and preventing a void marking from being printed along with an indicia (figure 5B). The printer receives data to be printed from a server (i.e. processor, memory, input/processor) (figure 1; column/line 3/57-4/10), therefore to one of ordinary skill, the data or print signals is expressed in binary form. Further, when tampering is not detected, the server instructs the printer to print a postage

indicium and a validation (i.e. not void) mark (column 8, lines 45-58), hence the server [processor] (figure 1) prevents transmission of a void marking (figure 5B).

As per claim 3, it is well known to those of ordinary skill in postage metering to disable a postage meter if it is not operating correctly. Therefore, an obvious modification to the meter of Sievel et al. is to prevent the meter from printing if the system detects an error such as a print signal that comprises a void and an improper postage indicium (figure 5B).

As per claim 4, Sievel et al. teach printing a predefined void marking (column 8, lines 53-54). Sievel et al. do not specifically recite storing void markings as a bitmap. However, storing image and/or data to be printed on a mailpiece as a bitmap in memory is old and well-known, therefore, it would have been obvious to one of ordinary skill to print the postage and void marking of Sievel et al. using bitmaps.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

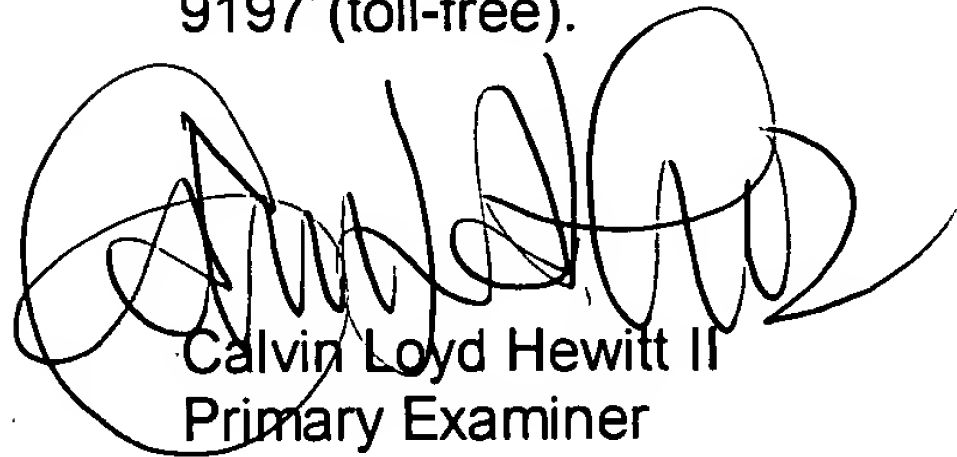


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<http://pairedirect.uspto.gov>. Should you have questions on access to the

Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-

9197 (toll-free).



Calvin Loyd Hewitt II  
Primary Examiner

October 10, 2006